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EXAMINER
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ARANI, TAGHI T

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/885,415

Applicant(s)

SHAMOON, TALAL G.

Examiner

Taghi T. Arani

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-20 have been examined.

#### **Response to Amendment**

2. Applicant's arguments filed 3/23/205 regarding the rejection of the claims 1-10 under 35 U.S.C. 102 (b) have been fully considered but they are not persuasive.

Applicant's attempt to distinguish the claims from prior art is based on noting the lack of a teaching of "a retrofitting appliance as claimed by Applicants".

The Examiner responds Chaney's smart card and descrambler in the television receiver broadly constitute the claimed retrofitting appliance as addressed in the previous office action and below.

Applicant further argues (with respect to claim 3) that Chaney does not disclose rendering the encoded electronic content and encoded control information through the output of the first electronic appliance; receiving the rendered electronic content and control information at a second electronic appliance; and decoding the rendered electronic content and control information to recover decoded electronic content and decoded control information.

The Examiner responds that Chaney's consumer electronic device (CE, or television receiver) processes and renders encoded electronic content and the smart card processes data such as security control information (col. 1, line 40, col. 2, line 20+) correspond to the claimed first electronic appliance and the descrambler (col. 2, line 13+) which descrambles the data component of the input signal (e.g. video and audio signal) in accordance with the control signal provided by the smart card correspond to the claimed second electronic appliance as addressed in the rejection of claims 1, 2 and 11 below.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-17, 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Chaney (USP 6,035,037).

As per claims 1 and 11, Chaney teaches an electronic appliance for (a) receiving encoded content and encoded control information, the encoded control information specifying, at least in part, how a decoded version of the encoded content may be used (col. 1, lines 50-55), and (b) rendering the encoded content and the encoded control information through an output of the electronic appliance (col. 2, line 13), the output of the electronic appliance being designed to be coupled to an output device for presenting content to a user of the electronic appliance [col. 2, lines 18-19];

a retrofitting appliance for (a) accepting the encoded content and the encoded control information from the output of the electronic appliance (col. 1, lines 40-60, i.e. a smart card processes security control information as part of an access control protocol), (b) decoding, at least in part, the encoded control information to obtain a decoded version of the encoded control information (the IC in the smart card includes processor performs various security control functions including entitlement management and generating the key for descrambling the scrambled data component of the signal) , and using the decoded control information to at least:

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in part govern the use of decoded content corresponding to the encoded content (col. 7, lines 16-17); and an output device connected to an output of the retrofitting appliance for presenting decoded content to a user of the electronic appliance (col. 2, lines 20-23).

**As per claims 2 and 12**, Chaney teaches the electronic appliance is selected from the group consisting of: CD player, DVD player, video cassette player, and television set-top box (col. 16, line 44).

**As per claim 3**, Chaney teaches receiving encoded electronic content and encoded control information at a first electronic appliance, the encoded electronic content and encoded control information forming part of a data signal encoded in a rendering format supported by the first: electronic appliance (col. 4, lines 34-38);

rendering the encoded electronic content and encoded control information through the output of the first electronic appliance (col. 4, lines 42-49);

receiving the rendered electronic content and control information at a second electronic appliance (col. 2, line 12);

decoding the rendered electronic content and control information to recover decoded electronic content and decoded control information (col. 2, lines, 12-14);

using the decoded control information to determine whether or not to permit at least one use of the decoded electronic content (col. 1, line 50);

transmitting the decoded electronic content to an output device if the at least one use is permitted (col. 2, line 19).

**As per claim 4**, Chaney teaches the encoded electronic content and encoded control the first electronic appliance in digital format receives information, and in which the rendered electronic content and control information comprise an analog signal (col. 16, line 63).

**As per claim 5**, Chaney teaches performing an analog-to-digital conversion on the rendered electronic content and control information to obtain a digital signal (col. 16, line 60).

**As per claim 6**, Chaney teaches decrypting the digital signal to obtain a decrypted digital signal (col. 2, line 11).

**As per claim 7**, Chaney teaches applying an error-correction transformation on' the digital signal (col. 4, lines 40-45).

**As per claim 8**, Chaney teaches decompressing the decrypted digital signal (col. 6, line 16).

**As per claim 9**, Chaney teaches television set-top box; compact disc player; digital versatile disc player; cellular telephone; personal digital assistant; and personal computer (col. 2, lines 23-24).

**As per claims 10 and 13**, Chaney teaches the first electronic appliance in a format selected from the group consisting of: Red Book CD format; MPEG- 1 format; MPEG-2 format; MPEG-3 format; MPEG-4 format; and DVD format (col. 16, line 44).

**As per claim 14**, Chaney teaches the fixed content delivery channel consists of a television set-top box, and wherein the rendering device consists of a television (col. 2, lines 23-24).

**As per claim 15**, Chaney teaches the encoded content is delivered separately from the at least one rule ( col. 2, lines 6-11).

**As per claim 16**, Chaney teaches the encoded content is delivered with the at least one rule (col. 4, lines, 15-18, lines 56-67).

**As per claim 17**, Chaney teaches the encoded content is received at the fixed content delivery channel after the at least one rule (col. 4, lines 36-40).

**As per claim 19**, Chaney teaches the communication is decrypted by the retrofitting appliance prior to being transmitted to the rendering device (col. 11, lines 40-56).

**As per claim 20**, Chaney teaches the retrofitting appliance performs analog-to-digital conversion and re-sampling on the communication prior to transmitting the decoded content to the rendering device (col. 16, line 60).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chaney as applied to claim 15 above, and further in view of Eistermann (USP 6,771,657).

Chaney fails to teach the encoded content is received at the fixed content delivery channel before the at least one rule.

However, in an analogous art, Eistermann teaches receiving encoded content before the at least one rule (col. 3, lines 25-39).

Therefore, it would have been obvious to one of ordinary skill in the art to employ the teaching of Eistermann within the system of Chaney with the motivation to allow the system of

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Chaney to deliver targeted advertisement and non-real-time events for subsequent playback and later viewing (Eistermann, col. 3, lines 35-39).

***Action is Final***

**5. THIS ACTION IS FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

**Conclusion**

**6.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taghi T. Arani whose telephone number is (571) 272-3787. The examiner can normally be reached on 8:00-5:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Taghi T. Arani, Ph.D.

Examiner

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**EMMANUEL L. MOISE**  
**SUPERVISORY PATENT EXAMINER**